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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,562	10/31/2003	Tao Jiang	02307E-161500US	1597
20350 7590 11/30/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER JONES, DAMERON LEVEST	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 11/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/699,562	Applicant(s) JIANG ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32, 37, 45-53 and 56 is/are pending in the application.
- 4a) Of the above claim(s) 49-53 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 46-48 is/are allowed.
- 6) ☒ Claim(s) 11 is/are rejected.
- 7) ☒ Claim(s) 12-32, 37, 45, and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 9/14/07 wherein claims 1, 11, and 46 were amended and claims 33-36, and 38-44, 54, and 55 were canceled.

Note: Claims 1-32, 37, 45-53, and 56 are pending.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/07 has been entered.

RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS

3. The Applicant's arguments and/or amendment filed 9/14/07 to the rejection of the claims made by the Examiner under 35 USC 112 and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

112 First Paragraph Rejection

The 112 first paragraph rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejections.

112 Second Paragraph Rejection

The 112 second paragraph rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejections.

Obviousness-Type Double Patenting Rejection

Claim 11 is provisional rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 6, and 21 of copending application number 11/133,804 for reasons of record in the office action mailed 6/14/07.

Claim 11 is provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 6, and 21 of copending application number 11/437,095 for reasons of record in the office action mailed 6/14/07.

Note: It is duly noted that Applicant respectfully requested that the double patenting rejections be held in abeyance until such time as the application is otherwise deemed to be in condition for allowance.

WITHDRAWN CLAIMS

4. Claims 49-53 are withdrawn from further consideration by the Examiner, 37 CFR 1,142(b), as being drawn to a non-elected invention.

ALLOWABLE CLAIMS

5. Claims 1-10 and 46-48 are allowable over the prior art of record.

CLAIM OBJECTIONS

6. Claims 12-32, 37, 45, and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

COMMENTS/NOTES

7. It is once again noted that no prior art has been cited against the instant invention. However, Applicant MUST address and overcome the double patenting

rejection. In particular, the claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious molecular products as set forth in independent claims 1, 11, and 46 comprising SEQ ID No. 1.

8. Applicant is reminded of the rejoinder paragraph which appeared in the restriction requirement mailed 7/13/06. In particular, the paragraph discloses that since the Examiner required a restriction between product and process claims, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. However, in the event of rejoinder, in order for the claims to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the

limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

In the instant invention, the claims have not been rejoined because they are not commensurate in scope with the product claims. Furthermore, it should be noted that the withdrawn process claims have not been reviewed for double patenting issues with other applications filed by Applicant. In addition, it is noted that the claims have 112 first and second paragraph issues.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "D. L. Jones", with a stylized, cursive script.

D. L. Jones
Primary Examiner
Art Unit 1618

November 23, 2007